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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,097	06/15/2001	Valerie De La Poterie	05725.0905-00	7312

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 04/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,097

Applicant(s)

DE LA POTERIE ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-18, 20-56 and 59 is/are rejected.
- 7) ☐ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed 1/10/03. Claims pending are 1-59. Claims 57 and 58 remain withdrawn from consideration as directed to non-elected invention.

Terminal Disclaimer

1. The terminal disclaimer filed on 1/10/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,464,969 and any patent granted on Application No. 09/880,787 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejection of Claims 1-18, 20-31 and 46-56 under 35 U.S.C. 102(e) as being anticipated by Bodelin et al. is maintained for the reasons of the record.

Claim Rejections - 35 USC § 103

4. The rejection of Claims 32-45 under 35 U.S.C. 103(a) as being unpatentable over Bodelin et al. in view of Simon and Mougin et al. is maintained for the reasons of the record.

5. The rejection of Claim 59 under 35 U.S.C. 103(a) as being unpatentable over Bodelin et al. is maintained for the reasons of the record.

Response to Arguments

6. Applicant's arguments filed 1/10/03 have been fully considered but they are not persuasive.

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The Applicant argues that “Comparative Example 12 comprising a polyethylene wax with a melting point of 83.9°C does not, at the temperature of the keratinous material, form a film having resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes as presently claimed. Accordingly, Bodelin’s compositions are not necessarily and inevitably capable, at the temperature of the keratinous material, of forming a film having resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes as presently claimed”. See pp. 5-6 of the Response. In response, it is noted that the Comparative Example 12 of the instant specification contains only one polyethylene wax having a melting point of 83.9°C, while the compositions of Bodelin et al. contain a combination of waxes such as high melting point waxes (70°C to 110°C) and low melting point waxes (45°C or 70°C) in a weight proportion of 0.2 to 1. See col. 8, lines 10-13. In addition, the compositions of Bodelin et al. contain at least one film-forming polymer of the instant invention. Thus, the Applicant’s Example 12 is not sufficient to show that because the Bodelin’s compositions may contain high melting point wax, they are not *capable*, at the temperature of the keratinous material, of forming a film having resistance (Rc) to hot water maintained at 40°C, of less than or equal to 15 minutes, and a resistance (Rf) to cold water, maintained at 20°C such that $R_f - R_c \geq 8$ minutes as presently claimed. Since only alleged distinction between applicants’ claim and reference is recited in functional language, it is incumbent upon applicants, when challenged, to show that the composition disclosed by reference does not actually possess such characteristics. In re Ludtke, 169 USPQ 563 (CCPA 1971).

Allowable Subject Matter

7. Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

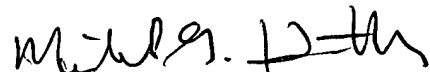
The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml
4/2/03

A large, stylized handwritten signature in black ink, appearing to be 'ml', is written over the typed text 'ml' and '4/2/03'.


MICHAEL G. HARTLEY
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to be 'Michael G. Hartley', is written above the typed name and title.